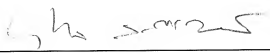


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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 1160215-0514436	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____		Application Number 10/666,631	
		Filed September 18, 2003	
		First Named Inventor Robert Birch	
		Art Unit 3691	Examiner Clement B. Graham
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.   This request is being filed with a notice of appeal.   The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 60,477 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature William S. Morris Typed or printed name 513-651-6800 Telephone number November 7, 2011 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE**

Applicant: Birch, et al. : Atty. Ref: 1160215-0514436  
Serial No. 10/666,631 : Group Art Unit: 3691  
Filed: September 18, 2003 : Examiner: Clement B. Graham  
For: **SYSTEM AND METHOD FOR WEB SERVICE BILLING**

**ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**  
In accordance with 1296 Off. Gaz. Pat. Office 67 (July 12, 2005)

Dear Sir:

The Final Office Action, dated August 5, 2011, ("Final Office Action") rejected claims 1-20 as obvious over U.S. 6,578,015 ("Haseltine") in view of U.S. 6,792,460 ("Oulu"). However, as set forth below, these rejections included clear legal and factual errors, not the least of which is that the Final Office Action simply failed to consider any of the amendments made in the office action response filed May 19, 2011 (the "May 19 Response"). Therefore, the applicants request that the panel withdraw the Final Office Action's rejections, and allow the pending claims, which have been under active prosecution without a request for continuing examination since 2007.

The concise arguments for which review is requested are set forth below.

### **Argument 1: The Final Office Action Ignored the Amendments from the May 19 Response**

The most obvious error in the Final Office Action is that it ignored the amendments from the May 19 Response. In that response, the applicants amended claims 16, 19, and 20, added new claims 21 and 22, and canceled then pending claims 17 and 18. As explained in the May 19 Response, whatever merits the rejections of the previous versions of claims 16, 19, and 20 may have had, in light of the amendments, those claims were patentable over the prior art.<sup>1</sup> The applicants also pointed out distinctly how claims 21 and 22 were patentable over the cited art – for example, noting that the cited art does not teach or suggest “extracting usage and billing authorization data from a web service message stream based on the one or more pre-defined elements designated by the descriptor file,” the function of a means plus function limitation set forth in clause (b) of claim 21.<sup>2</sup> The Final Office Action, rather than either indicating that the amended claims were allowable, or explaining why the limitations in those claims were believed to be present in the prior art, did not address the applicants’ position. Indeed, the Final Office Action did not mention the amendments from the May 19<sup>th</sup> Response at all. Instead, it rejected the claims which were pending prior to the May 19 Response, including no longer pending claims 17 and 18.<sup>3</sup> This is inconsistent with the requirements of examination as established by the patent act,<sup>4</sup> the Code of Federal Regulations,<sup>5</sup> and the cases of the Federal Circuit<sup>6</sup> and its predecessor court.<sup>7</sup> Accordingly, the (non)treatment of newly-added claims 21 and 22 and amended claims 16, 19, and 20 in the Final Office Action is a clear legal error based upon which the Final Office Action should be withdrawn.

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<sup>1</sup> See May 19 Response at 12-13 (stating that monitoring a web service network communication is not taught in Haseltine regarding claims 16, 19, and 20).

<sup>2</sup> See May 19 Response at 13-14.

<sup>3</sup> The rejections of claims 17 and 18 are on pages 6-7 of the Final Office Action.

<sup>4</sup> 35 U.S.C. § 132(a) (“Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.”);

<sup>5</sup> 37 C.F.R. 1.104(b) (“The examiner’s action will be complete as to all matters”); 37 C.F.R. 1.104(c)(2) (“The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”).

<sup>6</sup> *E.g., Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

<sup>7</sup> *E.g., In re Wilke*, 314 F.2d 558, 562 (C.C.P.A. 1963) (Noting “the clear intent of 35 U.S.C. § 132 that the examiner should so state the rejection that there is no ambiguity as to the grounds therefor.”).

## **Argument 2: The Office has Made a Clear Factual Error in Rejecting Unamended Claim 1**

Claim 1 recites “configuring a handler ... to monitor a web service network communication, between a service requestor and a service provider, for said predefined element in said descriptor file.”<sup>8</sup> The Office’s assertion that claim 1 is rendered obvious by the combination of Haseltine and Oulu is clearly erroneous because Haseltine, the reference relied on by the Office as teaching the above step, simply does not teach configuring a handler to perform the recited monitoring. The first section of Haseltine cited as teaching that limitation, lines 1-30 of column 3, discloses the acts of “presenting an electronic bill”<sup>9</sup>, “receiving biller-originated bill data”<sup>10</sup>, “storing the inputted bill data”<sup>11</sup>, “swapping the validated bill data”<sup>12</sup>, and “presenting the bill to the customer.”<sup>13</sup> None of these activities teach or suggest the monitoring of a web service network communication between a service requestor and a service provider as recited in claim 1. The second section of Haseltine cited by the Office, lines 31-46 of column 11, teaches that a bill generation and payment cycle can include a biller submitting bill payment and format data to a translator which would transform it into a format suitable for storage in a database.<sup>14</sup> That section also indicates that the translator can convert legacy bill data into a new format.<sup>15</sup> It does not teach or suggest a web service network communication between a service requestor and a service provider, or the monitoring of the same. Finally, the Office asserted that recording events in an activity log and maintaining an audit trail of activities that affect a database “represents the use of activity logging software to track or monitor web service of bill presentments and payment transactions between a customer and a biller.”<sup>16</sup> However, in Haseltine, bill presentments and payments are not made as part of a web service network communication between a service requestor and a service provider. Rather, they are made only after any related web service network communication is complete.<sup>17</sup> Accordingly, the rejections of claim 1 and the claims

<sup>8</sup> This step is set forth in the third clause after the preamble of claim 1.

<sup>9</sup> Haseltine, col. 3, ll. 3-4.

<sup>10</sup> Haseltine, col. 3, ll. 6.

<sup>11</sup> Haseltine, col. 3, ll. 9.

<sup>12</sup> Haseltine, col. 3, ll. 12-13.

<sup>13</sup> Haseltine, col. 3 ll. 16.

<sup>14</sup> Haseltine, col. 11, ll. 34-38.

<sup>15</sup> Haseltine, col. 11, ll. 38-41.

<sup>16</sup> Final Office Action at 8.

<sup>17</sup> See May 19<sup>th</sup> Response at 8-9 (discussing operation of Haseltine). Additionally, as set forth in footnote 14 of the May 19<sup>th</sup> Response, Haseltine does not actually disclose that billing information in the presentment and payment database of Haseltine comprises charges for web services. However, as set forth in the text, even if this distinction is ignored, Haseltine still does not justify the rejection of claim 1.

which depend therefrom are improper and should be withdrawn as dependent on a clear error of fact.

**Argument 3: Rather than Reopening Prosecution, the Applicants' Claims Should be Allowed in Their Current Form**

The applicants filed the present application on September 18, 2003, and active prosecution began in July of 2007. The Office has since issued seven Office Actions during the course of which the Office's rejections have been repeatedly overcome without filing a single request for continued examination. Also during that time period, in an attempt to reach a resolution to the present case, the applicants filed an appeal brief on December 27, 2010, after which the Office simply issued another non-final Office Action. The end result is that prosecution of the present application has extended across seven actions over the course of over eight years as well as the filing of an appeal brief.

It is well-established that the Patent Office has the initial burden of setting forth a *prima facie* case of unpatentability.<sup>18</sup> If the Office cannot meet its burden, then the applicant is entitled to a patent.<sup>19</sup> In the present case, the Office has failed to meet this burden. Additionally, the long history of repeated and unsuccessful attempt to find art which could render the applicants' technology unpatentable strongly indicates that that burden simply cannot be met. Accordingly, re-opening prosecution without allowing the claims would only extend this seemingly endless string of new grounds of rejection. This would have the practical effect of improperly denying the applicants protection for their invention despite no showing of unpatentability having been made, and would be clearly inconsistent with the policy of the Office to provide expeditious examination of applications.<sup>20</sup> As a result, the applicants request that the current claims be allowed, based on the clear errors in the Final Office Action and the long history of this application described above.

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<sup>18</sup> *In re Sullivan*, 498 F.3d 1345, 1351 (2007) ("It is well settled that the PTO 'bears the initial burden of presenting a prima facie case of unpatentability...'); *See also* MPEP § 2106.

<sup>19</sup> *See, e.g., In re Rouffet*, 149 F.3d 1350, 1355 (1998) ("In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.").

<sup>20</sup> *See, e.g., MPEP 707.07(g)* ("Piecemeal Examination").

### Conclusion

The applicants note that due to the length and content restrictions of the pre-appeal review program, this paper does not include all arguments related to the pending claims. To the extent that the applicants have not addressed certain aspects of the present rejection, please do not construe the same as an admission as to the merits of the rejections. Indeed, applicants reserve all rights with respect to arguments not explicitly raised herein.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

**Birch, et al.**

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